

1 Roger G. Perkins, Esq., CSB #86617
Rperkins@mpplaw.com
2 Angela Kim, Esq., CSB #216374
Akim@mpplaw.com
3 MORRIS POLICH & PURDY LLP
501 West Broadway, Suite 500
4 San Diego, California 92101
Telephone: (619) 557-0404
5 Facsimile: (619) 557-0460

6 Robert S. Mallin, Illinois Bar No. 6205051
Rmallin@brinkshofer.com
7 Brinks Hofer Gilson & Lione
NBC Tower, Suite 3600
8 455 North Cityfront Plaza Drive
Chicago, IL 60611-5599
9 Telephone: (312) 321-4221
Facsimile: (312) 321-4299

10 **Attorneys for Defendant Senco Products, Inc.**

11
12 **UNITED STATES DISTRICT COURT**
13 **SOUTHERN DISTRICT OF CALIFORNIA**

14 JENS ERIK SORENSEN, As Trustee of
15 SORENSEN RESEARCH AND
DEVELOPMENT TRUST,

16 Plaintiff,

17 v.

18 SENCO PRODUCTS, INC. an Ohio
19 Corporation; and DOES 1-100

20 Defendants.

CASE NO. 3:08-cv-00071-BTM-CAB

**SENCO PRODUCTS, INC.'S
RESPONSE TO COMPLAINT FOR
PATENT INFRINGEMENT,
AFFIRMATIVE DEFENSES AND
COUNTERCLAIMS**

[Hon. Barry Ted Moskowitz]

JURY TRIAL DEMANDED

21
22
23
24 **ANSWER TO COMPLAINT**

25 Defendant, Senco Products, Inc. ("SENCO") answers the allegations of plaintiff, Jens Erik
26 Sorensen, as trustee of Sorensen Research and Development Trust ("SRDT") and asserts affirmative
27 defenses and counterclaims as set forth below, solely on its own behalf. SENCO is without knowledge
28

**SENCO PRODUCTS, INC.'S RESPONSE TO COMPLAINT FOR PATENT INFRINGEMENT, AFFIRMATIVE
DEFENSES AND COUNTERCLAIMS**

3:08-CV-00071-BTM-CAB

1 or information sufficient to form a belief as to the truth of the allegations set forth in SRDT's Complaint
2 with respect to the defendants referred to as DOES 1-100, and therefore denies the allegations with
3 respect to them. To the extent that any response to the conclusory headings used in the complaint may
4 be deemed required, SENCO denies any allegations set forth in those headings. SENCO denies any
5 allegation not deemed to be addressed below, if any, to the extent that the allegation is deemed to require
6 a response.

7 **THE PARTIES**

8 1. SENCO is without knowledge or information sufficient to form a belief as to the truth of
9 the allegations and therefore denies the allegations except that SENCO admits that with the exception of
10 the numbering, Exhibit A appears to be a true and correct copy of U.S. Patent No. 4,935,184 ("the '184
11 patent").

12 2. Admitted.

13 3. SENCO is without knowledge or information sufficient to form a belief as to the truth of
14 the allegations and therefore denies the allegations.

15 4. Denied.

16 5. SENCO admits that it sells the DS200-AC but denies the remainder of the allegations.

17 **JURISDICTION AND VENUE**

18 6. Admitted that this action purports to be for alleged patent infringement.

19 7. SENCO admits that venue is proper but denies the remainder of the allegations.

20 8. SENCO admits that this court has personal jurisdiction but denies the remainder of the
21 allegations.

22 **GENERAL ALLEGATIONS**

23 9. Admitted.

24 10. Denied.

25 11. SENCO admits that it received a letter in July 2005 from an attorney purporting to
26 represent "Sorensen Research & Development Trust" where the letter identified the '184 patent, but
27 denies the remainder of the allegations.

1 12. SENCO admits that it sells the DS200-AC within the United States but denies the
2 remainder of the allegations.

3 13. Denied.

4 14. SENCO admits that no license has been obtained because no license is required. Denied
5 as to the remainder of the allegations.

6 **CLAIM 1 – PATENT INFRINGEMENT**

7 15. SENCO realleges and incorporates herein by reference paragraphs 1 through 14,
8 inclusive, as though fully set forth herein.

9 16. SENCO admits that it sells the DS200-AC but denies the remainder of the allegations.

10 17. SENCO admits that it sells the DS200-AC but denies the remainder of the allegations.

11 18. Denied.

12 19. Denied.

13 20. [RESERVED].

14 21. Denied.

15 22. Denied.

16 23. Upon information and belief, Senco admits that the DS200-AC is manufactured in China
17 but denies the remainder of the allegations.

18 24. Denied.

19 25. Denied.

20 26. Denied.

21 27. Denied.

22 28. Denied.

23 29. Denied.

24 **AFFIRMATIVE DEFENSES**

25 1. SENCO has not and does not infringe, directly or indirectly, or actively induce others to
26 infringe, or contribute to the infringement by others because SENCO does not make, use, sell, offer to
27 sell or import any product manufactured by a process covered by any valid and enforceable claim of the
28

1 '184 patent and does not practice any process covered by any valid and enforceable claim of the '184
2 patent.

3 2. The claims of the '184 patent are invalid and/or unenforceable for failing to meet one or
4 more of the statutory requirements of 35 U.S.C. § 101 *et seq.*, including but not limited to 35 U.S.C.
5 §§ 102, 103 and/or 112.

6 3. SRDT's claim for damages (to the extent SRDT is entitled to any damages) is limited
7 because SRDT failed to provide notice as required by 35 U.S.C. § 287(b).

8 4. SRDT's claim for damages (to the extent SRDT is entitled to any damages) is limited by
9 the statute of limitations as set forth in 35 U.S.C. § 286.

10 5. SRDT's claim for damages (to the extent SRDT is entitled to any damages) is barred in
11 whole or in part by the equitable doctrine of laches.

12 6. SRDT's claim for damages (to the extent SRDT is entitled to any damages) is barred in
13 whole or in part by the equitable doctrine of equitable estoppel.

14 7. SRDT's claim for damages (to the extent SRDT is entitled to any damages) is barred in
15 whole or in part by the doctrine of prosecution history estoppel.

16 **RESPONSE TO SRDT'S PRAYER FOR RELIEF**

17 The allegations in the paragraph requesting relief are in the nature of a prayer. Although no
18 answer is required, SENCO responds to the individual requests for relief as follows:

19 a. SENCO denies that a judgment ordering that the Accused Processes are presumed to
20 infringe the '184 patent pursuant to 35 U.S.C. § 295 should be entered, and denies any and all liability of
21 Plaintiff's claims;

22 b. SENCO denies that a judgment adjudicating and decreeing the Defendants to have
23 infringed the '184 patent should be entered, and denies any and all liability of Plaintiff's claims;

24 c. SENCO denies that a judgment adjudicating and decreeing the Defendants to have
25 contributed to the infringement of the '184 patent and to have induced others to infringe the '184 patent
26 should be entered, and denies any and all liability of Plaintiff's claims;

1 d. SENCO denies that a judgment ordering the Defendants to account for damages adequate
2 to compensate Plaintiff for the infringement of the '184 patent should be entered, and denies all liability
3 of Plaintiff's claims;

4 e. SENCO denies that a judgment ordering that such damages as are awarded, to the extent
5 Plaintiff is entitled to any such damages, are trebled pursuant to 35 U.S.C. § 284 by reason of the willful,
6 wanton, and deliberate nature of the infringement should be entered, and denies any and all liability of
7 Plaintiff's claims;

8 f. SENCO denies that a judgment decreeing this case to be an "exceptional case" and
9 awarding SRDT reasonable attorneys' fees pursuant to 35 U.S.C. § 285 should be entered, and denies
10 any and all liability of Plaintiff's claims;

11 g. SENCO denies that a judgment awarding interest on such damages, to the extent Plaintiff
12 is entitled to any such damages, should be entered, denies any and all liability of Plaintiff's claims;

13 h. SENCO denies that a judgment awarding costs of suit herein incurred by Plaintiff should
14 be entered, and denies any and all liability of Plaintiff's claims; and

15 i. SENCO denies that a judgment should be entered for such other and further relief in
16 favor of the Plaintiff, and denies any and all liability of Plaintiff's claims.

17 **COUNTERCLAIMS**

18 1. Counterclaim Plaintiff SENCO is an Ohio corporation having a principal place of
19 business at 8485 Broadwell Road, Cincinnati, OH 45244.

20 2. SRDT has alleged that Counterclaim Defendant SRDT is a California resident and trustee
21 of a trust organized according to California law, and owner of all rights that may exist to the '184 patent.

22 3. This Court has subject matter jurisdiction under 28 U.S.C. §§ 1331, 1332, 1337(a),
23 1338(a), and 1367.

24 4. Personal jurisdiction is proper in this judicial district.

25 5. Venue is proper in this judicial district under 28 U.S.C. § 1391(b) and (c).

26 6. SRDT has alleged that SENCO is infringing one or more of the claims of the '184 patent
27 by manufacturing, importing into, selling and/or offering for sale in the United States the DS200-AC.
28

1 7. SRDT is seeking damages from SENCO for the alleged infringement of the '184 patent.

2 **FIRST COUNTERCLAIM**
3 **FOR DECLARATION OF NONINFRINGEMENT**

4 8. SENCO realleges and incorporates herein by reference paragraphs 1 through 7, inclusive,
5 as though fully set forth herein.

6 9. This is an action under the Federal Declaratory Judgments Act, 28 U.S.C. §§ 2201 and
7 2202 and pursuant to the patent laws of the United States, 35 U.S.C. § 1 *et seq.*

8 10. SENCO has not and does not directly infringe, contributorily infringe or actively induce
9 others to infringe any valid claim of the '184 patent by manufacturing, importing into, selling, and/or
10 offering for sale in the United States any of the accused DS200-AC, or by practicing any method
11 covered by a valid and enforceable claim of the '184 patent.

12 **SECOND COUNTERCLAIM**
13 **FOR DECLARATION OF PATENT INVALIDITY**

14 11. SENCO realleges and incorporates herein by reference paragraphs 1 through 10,
15 inclusive, as though fully set forth herein.

16 12. The '184 patent is the subject of two granted requests for reexamination in the United
17 States Patent and Trademark Office ("the PTO").

18 13. The PTO has found more than twenty substantial new questions of patentability based on
19 numerous prior art references that anticipate or render obvious the claims of the '184 patent.

20 14. This is an action under the Federal Declaratory Judgments Act, 28 U.S.C. §§ 2201 and
21 2202, and pursuant to the patent laws of the United States, 35 U.S.C. § 1 *et seq.*

22 15. The claims of the '184 patent are invalid for failing to meet one or more of the statutory
23 requirements of 35 U.S.C. § 101 *et seq.*, including but not limited to 35 U.S.C. §§ 102, 103 and/or 112.

24 **PRAYER FOR RELIEF**

25 WHEREFORE, SENCO prays for relief against SRDT as follows:

- 26 1. For a declaration that SENCO does not infringe any valid claim of the '184 patent;
27 2. For a declaration that the claims of the '184 patent are invalid and/or unenforceable;

1 3. For a declaration that this is an exceptional case under 35 U.S.C. § 285 and for an award
2 to SENCO of its attorneys' fees and expenses in this action; and

3 4. For such relief as the Court may deem just and proper.

4 **DEMAND FOR JURY TRIAL**

5 Pursuant to FED. R. CIV. P. 38(b), SENCO hereby demands a trial by jury of all issues so triable
6 in this action.

7
8 Date: March 5, 2008

MORRIS POLICH & PURDY, LLP

9
10 By: s/Angela Kim
11 Attorneys for Defendant
12 SENCO PRODUCTS, INC.
 Akim@mpplaw.com

13 Robert S. Mallin
14 Brinks Hofer Gilson & Lione
15 NBC Tower, Suite 3600
 455 North Cityfront Plaza Drive
 Chicago, Illinois 60611-5599

16 Attorneys for Defendant
17 SENCO PRODUCTS, INC.
18
19
20
21
22
23
24
25
26
27
28

Jens Erik Sorensen v. Senco Products, Inc.
U.S. District Court, Southern District, Case No. 3:08-cv-00071-BTM-CAB

CERTIFICATE OF SERVICE

I am employed in San Diego County. I am over the age of 18 and not a party to this action. My business address is 501 West Broadway, Suite 500, San Diego, California 92101-3544.

On March 5, 2008, I served a copy of the foregoing document(s) entitled: **SENCO PRODUCTS, INC.'S RESPONSE TO COMPLAINT FOR PATENT INFRINGEMENT, AFFIRMATIVE DEFENSES AND COUNTERCLAIMS** to all parties in this action.

SEE SERVICE LIST

Melody A. Kramer, Esq. CSB #169984
Mak@kramerlawip.com
Kramer Law Office, Inc.
9930 Mesa Rim Road, Suite 1600
San Diego, CA 92121
619/993-0874

Attorney for Plaintiff

J. J. Michael Kaler, Esq.
michael@kalerlaw.com
9930 Mesa Rim Road, Suite 200
San Diego, California 92121
858/362-3151

Attorney for Plaintiff

☒ **ELECTRONIC FILING**

☒ **FEDERAL** I declare that I am employed in the office of a member of the bar of this court at whose direction the service was made.

Executed on March 5, 2008, at San Diego, California.


NANCY DAVIS

PROOF OF SERVICE
3:08-cv-00071-BTM-CAB